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HC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/198,427 11/24/98 BRIEDEN

W A32113

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-0228

HM12/1214

EXAMINER

BERCH, M

ART UNIT	PAPER NUMBER
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1611

DATE MAILED:

12/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/198,427

Applicant(s)
Briedon

Examiner
Mark L. Berch

Group Art Unit
1611



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim none, drawn to Process involving enzyme resolution, classified in class 435, subclass 280.
- II. Claim none, drawn to Process involving chemical resolution, classified in class 544, subclass 277.
- III. Claim 10, drawn to Ester hydrolysis, classified in class 564, subclass 1.

Claims 8, 9 and 11 link Groups I and II, and hence will be examined, to the extent that they read on the elected invention, with whichever of Groups I and II are elected, if applicants do not elect Group III.

In addition, if either of Groups I or II is elected, claims 1-7 and 12-14 will be examined with the elected invention. These are drawn to steps which are included in the independent claim 11.

The inventions are distinct, each from the other because of the following reasons: Chemical and biological processes are distinct because they are fundamentally different, and cannot be considered equivalent. With regard to group III, this step does not appear in either of the other processes. Because these inventions are distinct for the reasons given above and have acquired a separate

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status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Carmella Stephens on behalf of Mr. Tang on 12/8/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

Mark L. Berch

Primary Examiner

Group 1610 - Art Unit 1611

December 10, 1999

A handwritten signature in black ink, appearing to read "Mark L. Berch", is written over the printed name of the examiner.